

### Remarks

The above Amendments and these Remarks are in reply to the Office action mailed August 11, 2003. Claims 1-5 and 7-17 are presented herewith for consideration.

#### I. Summary of the Examiner's Rejections

Claims 1- 17 were rejected under 35 U.S.C. §102(e) as being anticipated by Kucala et al. (U.S. Patent No. 5,727,202 (Kucala et al.)).

#### II. Remarks

Applicants initially respectfully request that the finality of the Office Action be withdrawn. M.P.E.P. §706.07(a), relating to the propriety of final rejections, states in part:

Under present practice, second or any subsequent actions on the merits shall be final, **except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).** (Emphasis added).

The Examiner has introduced a new ground of rejection. Namely, the claims are for the first time rejected over Kucala et al. The rejection over this reference was not raised in the previous Office Action.

Therefore, the finality of the rejection will be premature unless:

- a) the new rejection was necessitated by applicants' amendment; or
- b) the new rejection was based on an information disclosure statement.

The Examiner states that "[a]pplicant's amendment necessitated the new grounds of rejection presented in this Office action." However, applicants made no amendments that would necessitate the new grounds of rejection. In fact, the only amendment made was the amendment to the preamble of Claim 5, which did not require the new grounds of rejection. Nor was there an information disclosure statement filed that would have necessitated the finality of the rejection.

Therefore, based on the above, it is respectfully requested that the finality of the rejection be withdrawn.

Turning now to the merits of the rejection, applicants respectfully traverse the rejection as follows.

Kucala et al. discloses a synchronization system between a Palm computer and a personal computer. There is no disclosure of a network, nor any manner of connection the Palm computer to the personal computer other than by a direct cable connection between the two devices. The reference teaches a synchronization process using three files – a “backup” file containing a record of a previous synchronization of the personal computer and the Palm computer, the Palm computer’s file, and the personal computer’s file. The entire sync process is performed on the personal computer for both devices. The three files are used to create a “reconcile” file, which is a file containing all the records which should be in the respective calendar files of both the Palm and personal computers. (Col 3, lines 45 – 53). Because both the separate files on the personal computer and the Palm computer can change between synchronizations, the backup file on the personal computer is necessary to allow the method to determine which individual records in each respective calendar file have changed (or whether the record has changed in both files) in order to determine how to handle such changes in the reconcile file. The table of Column 4, lines 1 – 36 of Kucala et al. indicates conditions for adding or modifying records in the reconcile file.

In order to support a Section 102 rejection, the Examiner must show that each claim limitation is found in the single prior art reference cited. *Apple Computer, Inc. v. Articulate Systems, Inc.*, 234 F.3d 14, 20 (Fed. Cir. 2000). Omission of any claimed element, no matter how insubstantial, is grounds for traversing a rejection based on §102. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542 (Fed. Cir. 1983).

The claimed invention differs from the cited reference in several respects. As one example, Claims 1-4 and 7-17 of the present invention each recite determining whether the identification number and field of the second transaction corresponds to the identification number and field of the first transaction. Exemplary is Claim 1, which recites the steps of:

determining whether the identification number of the second transaction corresponds to the identification number of the first transaction;

determining whether the field of the second transaction corresponds to one of the fields of the first transaction.

These limitations are nowhere disclosed, or in any way taught or suggested by Kucala et al. In particular, there is never a determination in Kucala et al. of whether PC record corresponds to the PALM record. The only determination that is made is whether the PC record corresponds to backup record, and whether the PALM record corresponds to the backup record. This leads to the scenario under Kucala et al. where a change in the PC record and a change in the PALM record would result in BOTH changes appearing in the backup record and then copied to the PC and PALM computers. As stated in Kucala et al.:

For example, in one embodiment, if a record is added into the calendar file on the palmtop 100 and a different record is added into the corresponding calendar file on the PC 200, then the synchronization system of the present invention will copy both records into the reconcile file. The reconcile file will later be copied back into the backup calendar file in the backup directory, the palmtop calendar file and the PC calendar file, synchronizing the records in the three calendar files. Similarly, if the same record is changed in one way in the palmtop calendar file and changed a different way in the PC calendar file, then both changed records will be copied into the reconcile file. Given that neither altered record will match any records in the backup file, both records will then appear as new records in the backup calendar file in the backup directory, the palmtop calendar file and the PC calendar file. (Col. 4, lines 44-58).

Thus, the addition of or changes to corresponding records in Kucala et al. will result in two records being generated in each of the PC, PALM computer and backup file. This does not happen in the system of the present invention. The record that would exist is only the record that is later in time.

Another significant distinction is that Kucala et al. performs the upload of an entire application file (in this case a calendar database file). This is extremely inefficient and would require extremely large amounts of bandwidth. That is why Kucala et al. only discloses only two devices (PALM and PC) and a direct cable connection between them. By contrast, the present invention does not upload an entire application file. The present invention uploads only changes to individual

records. This is reflected in each of the claims by the express recitation that a transaction includes fields having "change information."

The limitation of "change information" is nowhere disclosed, and is nowhere taught or suggested in the cited reference. As indicated, the records that are uploaded for comparison against the backup file in Kucala et al. is the entire application file – the records contain the actual data, not a change in data. Nowhere does Kucala et al. disclose or contemplate a record having only change information.

Based on the above, it is respectfully submitted that the present invention is patentable over Kucala et al., and it is respectfully requested that the rejection on the stated grounds be withdrawn.

#### Claims 8-17

Claims 8-17 are patentable over Kucala et al. for each of the reasons set forth above. However, in addition, applicants respectfully submit that the Examiner has not set forth a *prima facie* rejection, in as much as the Office action states that, "[a]s to claims 8-17, the limitations of these claims are either taught or suggested in the rejected claims of 1-7." While it is not clear, it would appear that the Examiner states that the limitations of Claims 8-17 are either taught or suggested by the cited reference. However, this is not the correct standard for a rejection under 35 U.S.C. §102. It is therefore further respectfully requested that the rejection of Claims 8-17 on the stated grounds be withdrawn.

Based on the above amendments and these remarks, reconsideration of claims 1-6 and 7-17 is respectfully requested.

The Examiner's prompt attention to this matter is greatly appreciated. Should further questions remain, the Examiner is invited to contact the undersigned attorney by telephone.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 501826 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

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